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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,817	03/29/2004	Avancesh Dubey	11884/414001	9999
23838 7590 03/05/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
ROSEN, ELIZABETH H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,817

Applicant(s)

DUBEY ET AL.

Examiner

ELIZABETH ROSEN

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the Application filed on March 29, 2004.
2. Claims 1-26 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 1, 9, 13, 14, 21, and 24** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. **Claims 1, 13, 21, and 24** include the limitation of link and linkage. It is unclear what is meant by this limitation. Is the data regarding the receivable linked? Is the actual receivable linked? Does link mean associated?
6. **Claim 9** includes the limitation of "*manually forming a link.*" However, Claim 9 includes the limitations of Claim 1, which automatically forms a link. It is unclear how the link can be formed manually when it is already being formed automatically.
7. **Claim 14** includes the limitation of "*a plurality of portions.*" It is unclear what is meant by this limitation. Does this mean that there are several sections or terms in the agreement?

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. **Claim 1-16 and 18-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kochansky et al.**, U.S. Patent Application Publication Number 2003/0144940 A1.

Claim 1:

Kochansky discloses the limitations of:

- *applying criteria for determining whether to [associate by transferring] a receivable to a collateral agreement* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Paragraph 0048 (Data from the agreement, including the terms of the agreement, is received by and stored in the system. Data regarding collateral is also stored in the system. The "agreement may contain several other terms or provisions that modify or otherwise effect the calculations and ultimate determination of whether a collateral transfer should occur."); and Paragraph 0050 (An exposure value is calculated and compared to the present worth of the collateral to determine whether the collateral should be transferred.)); and
- *if a receivable meets the criteria, automatically forming [an association] between the receivable and the collateral agreement* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Paragraph 0016 ("initiating a transfer of collateral held to collateral pledged if the difference between the computed exposure value and the threshold value is positive"); Paragraph 0048; and Paragraph 0050).

Kochansky, however, does not explicitly disclose:

- *link*.

However, Kochansky discloses, as cited in this rejection, that information regarding the agreement and the collateral is received and used to make the determination about whether to transfer the collateral held to pledged collateral. When the word "link" is interpreted in a broad and reasonable manner, it is disclosed in Kochansky. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of determining whether the collateral is covered by the agreement and should be pledged.

Claim 2:

Kochansky, however, does not explicitly disclose:

- *wherein the criteria include an identity of a party to the collateral agreement*.

However, Kochansky discloses that the "processor calculates an exposure value representing the current risk to the party associated with the transaction." (see Kochansky, Paragraph 0049). To make this calculation, information regarding the identity of the party would be essential. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of determining the identity of the party to the agreement so that the collateral is pledged to the correct party.

Claim 3:

Kochansky, however, does not explicitly disclose:

- *wherein the criteria include a type of receivable.*

However, Kochansky discloses that if the calculated exposure value is greater than the present worth of the collateral pledged, the system will transfer collateral from held to pledged (see Kochansky, Paragraphs 0048-0051). To transfer collateral from held to pledged, it would be essential to the invention in Kochansky that the type of receivable is included in the criteria so that the value of the receivable can be ascertained. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of determining the type of receivable so that the correct collateral is pledged and also to be certain that the collateral conforms to the agreement.

Claim 4:

Kochansky further discloses:

- *wherein the criteria are applied pursuant to the processing of a new or existing receivable* (see at least Kochansky, Paragraphs 0048-0051 (First the "collateral pledged" is applied to the agreement. If there is a "credit support deficit," then "collateral held as credit" is transferred to "collateral pledged."))

Claim 5:

Kochansky further discloses:

- *wherein the criteria are applied pursuant to the processing of a new or existing collateral agreement* (see at least Kochansky, Paragraphs 0048-0051).

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Claim 6:

Kochansky, however, does not explicitly disclose:

- *wherein the link is formed between the receivable and a portion of the collateral agreement.*

However, Kochansky discloses that an association is formed between the receivable and the collateral agreement (see the rejection for Claim 1). This limitation is an obvious substitution of what is disclosed in Kochansky. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of associating a receivable to a portion of the agreement rather than the entire agreement. An agreement may have several sections or list several types of collateral and it would be obvious that specific collateral could be linked only to where it is specified in the agreement rather than generally linked to the agreement.

Claim 7:

Kochansky, however, does not explicitly disclose:

- *wherein the link is formed between a component of the receivable and the collateral agreement.*

However, Kochansky discloses that an association is formed between the receivable and the collateral agreement (see the rejection for Claim 1). This limitation is an obvious substitution of what is disclosed in Kochansky. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of associating only a portion of a receivable with an agreement when only a portion of the receivable is to be pledged.

Claim 8:

Kochansky, however, does not explicitly disclose:

- *wherein the link is formed between a component of the receivable and a portion of the collateral agreement.*

However, Kochansky discloses that an association is formed between the receivable and the collateral agreement (see the rejection for Claim 1). This limitation is an obvious

substitution of what is disclosed in Kochansky. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of associating only a portion of a receivable with an agreement when only a portion of the receivable is to be pledged. Furthermore, an agreement may have several sections or list several types of collateral and it would be obvious that a specific portion of a collateral could be linked only to where it is specified in the agreement rather than generally linked to the agreement.

Claim 9:

Kochansky, however, does not explicitly disclose:

- *manually forming a link between a receivable and a collateral agreement.*

However, Kochansky discloses that an association is automatically formed between the receivable and the collateral agreement (see the rejection for Claim 1). It would be obvious to automate something that is done manually or to manually do something that is done automatically. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of forming a link manually as opposed to automatically.

Claim 10:

Claim 10 is rejected using the same rationale as the rejection for Claim 6.

Claim 11:

Claim 11 is rejected using the same rationale as the rejection for Claim 7.

Claim 12:

Claim 12 is rejected using the same rationale as the rejection for Claim 8.

Claim 13:

Kochansky discloses the limitations of:

- *a collateral agreement* (see at least Kochansky, Paragraph 0012);

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- [an association] *between the collateral agreement and a receivable secured by the collateral agreement* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Paragraph 0016; Paragraph 0048; and Paragraph 0050); and
- *wherein the [association] is formed automatically in accordance with criteria of a global declaration of purpose associated with the collateral agreement* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Figure 3 (The transfer determination is done automatically); Paragraph 0016; Paragraph 0048 (The invention in Kochansky uses criteria to determine whether to transfer collateral from collateral held as credit (i.e., "available for further credit support") to collateral pledged (i.e., "collateral already turned over")); and Paragraph 0050).

Kochansky, however, does not explicitly disclose:

- *link*.

However, Kochansky discloses, as cited in this rejection, that information regarding the agreement and the collateral is received and used to make the determination about whether to transfer the collateral held to pledged collateral. When the word "link" is interpreted in a broad and reasonable manner, it is disclosed in Kochansky. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of determining whether the collateral is covered by the agreement and should be pledged.

Claim 14:

Kochansky further discloses:

- *wherein the collateral agreement comprises a plurality of portions* (see at least Kochansky, Paragraph 0012 (The agreement has several terms.)).

Claim 15:

Kochansky, however, does not explicitly disclose:

- *wherein each of the portions has assigned thereto a value that is a part of a total value of the collateral agreement*.

However, Kochansky discloses an exposure value that represents the current risk to the party associated with the transaction. (see at least Paragraph 0049). This risk is based

on the agreement. This claimed limitation is an obvious substitution of the invention disclosed in Kochansky (i.e., assigning a value to portions of the agreement instead of assigning a value to the agreement as a whole). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of assigning a value, score, or identifier for each type of collateral listed in the agreement so that the collateral can be ranked and associated with the agreement.

Claim 16:

Kochansky further discloses:

- *wherein each of the portions has associated therewith distinct criteria for forming a link between a respective portion and a receivable secured by the collateral agreement* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Paragraph 0016; Paragraph 0048; and Paragraph 0050).

Claim 18:

Claim 18 is rejected using the same rationale as the rejection for Claim 6.

Claim 19:

Claim 19 is rejected using the same rationale as the rejection for Claim 7.

Claim 20:

Claim 20 is rejected using the same rationale as the rejection for Claim 8.

Claim 21:

Kochansky discloses the limitations of:

- *initiating a request for information concerning a collateral agreement or a receivable* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Paragraph 0016; Paragraph 0048 (Data from the agreement, including the terms of the agreement, is received by and stored in the system. Data regarding collateral is also stored in the system.); and Paragraph 0050); and

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- *based on the request, reading [association] information that maps collateral agreements to respective receivables* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Figure 3; Paragraph 0016; Paragraph 0048 (The invention in Kochansky uses criteria to determine whether to transfer collateral from collateral held as credit (i.e., "available for further credit support") to collateral pledged (i.e., "collateral already turned over")); and Paragraph 0050).

Kochansky, however, does not explicitly disclose:

- *linkage*.

However, Kochansky discloses, as cited in this rejection, that information regarding the agreement and the collateral is received and used to make the determination about whether to transfer the collateral held to pledged collateral. When the word "link" is interpreted in a broad and reasonable manner, it is disclosed in Kochansky. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of determining whether the collateral is covered by the agreement and should be pledged.

Claim 22:

Claim 22 is rejected using the same rationale as the rejection fro Claim 15.

Claim 23:

Kochansky further discloses:

- *wherein the linkage information maps the portions to respective receivables* (see at least Kochansky, Figure 1, Item 22 (Agreement Database), Item 24 (Portfolio Database); Figure 2; Paragraph 0016; Paragraph 0048; and Paragraph 0050).

Claim 24:

Claim 24 is rejected using the same rationale as the rejection for Claim 21.

Claim 25:

Claim 25 is rejected using the same rationale as the rejection for Claim 22.

Claim 26:

Claim 26 is rejected using the same rationale as the rejection for Claim 23.

10. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kochansky et al.**, U.S. Patent Application Publication Number 2003/0144940 A1 in view of **Atkins**, U.S. Patent Number 4,953,085.

Claim 17:

Kochansky does not disclose, but **Atkins**, however, does disclose:

- *wherein each portion has a priority* (see at least Atkins, column 14, lines 1-4 ("The client selects the assets to be used as collateral and the priority of all collateralization"))).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate Atkins' method of selecting the priority of all collateralization with Kochansky's system and method for facilitating collateral management. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of the priority of the collateral and what should be pledged.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- **Aziz et al.**, U.S. Patent Number 6,018,721, teaches a method and system for improved collateral monitoring and control.
 - **Brock**, U.S. Patent Application Publication Number 2003/0126072 A1, teaches a system and method for providing financing.
 - **Fox et al.**, U.S. Patent Application Publication Number 2001/0034701 A1, teaches a business process and system for managing and tracking loan collateral.
 - **Highbloom**, U.S. Patent Number 5,323,315, teaches a computer system for monitoring the status of individual items of personal property which serve as collateral for securing financing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Rosen whose telephone number is 571-270-1850. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/

Primary Examiner, Art Unit 3692